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RECORD OF ORAL HEARING
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex Parte PAVEL NOVAK

Appeal 2009-010849
Application 10/601,406
Technology Center 2400

Oral Hearing Held: June 10, 2010

Before JAMES D. THOMAS, MASHID D. SAADAT, and
CARL W. WHITEHEAD, Jr., *Administrative Patent Judges*.

APPEARANCES:

ON BEHALF OF THE APPELLANT:

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1 THE USHER: Calendar No. 28, Appeal No. 2009-010849,

2 Mr. Oberdick.

3 JUDGE THOMAS: Good morning. Have you been here before, sir?

4 MR. OBERDICK: Good morning, I have, yes.

5 JUDGE THOMAS: Okay. Is this your colleague?

6 MR. OBERDICK: I'm sorry?

7 JUDGE THOMAS: Is this a colleague of yours?

8 UNKNOWN SPEAKER: Just an observer.

9 JUDGE THOMAS: Okay. Do you have any objection to him being
10 present in the room?

11 MR. OBERDICK: No, sir.

12 JUDGE THOMAS: Okay, proceed.

13 MR. OBERDICK: If you don't have any questions, you'd just like me
14 to --

15 JUDGE THOMAS: Well, I would like to tell you we have a pretty
16 good understanding of the disclosed and claimed invention and the
17 references of record and the Examiner's positions as well as yours.

18 MR. OBERDICK: Okay.

19 JUDGE THOMAS: You can probably feel safe in proceeding on that
20 basis.

21 MR. OBERDICK: Okay. Like I said, as I'm sure you are aware then,
22 you know, basically and just very briefly what we're talking about is the, the
23 control system basically that relies on two separate networks. All of the
24 claims, and there are various embodiments, but one of the things that is
25 common to all of the claims, obviously, is the requirement for two networks,
26 the surgical network and what we call the ancillary network. Basically, you

1 know, you're probably also familiar with the reason behind providing the
2 two networks.

3 Essentially, certain types of networks have certain advantages. The
4 control network in this case, the surgical network, is in one embodiment. It's
5 a CAN, control area network, and provides certain advantages as far as very
6 easily allowing different devices to be plugged in and configured. It has,
7 without getting into the details, it has advantages, but it also has
8 disadvantages. It has relatively low bandwidth for when you're dealing with
9 certain types of video devices, and also there are devices that we would like
10 to control that are simply just not compatible. They're not sophisticated
11 enough to be compatible with the CAN network. So that's what the ancillary
12 network is provided for those two reasons. One is it takes care of devices
13 that have a higher bandwidth than the CAN is capable of transmitting. And
14 it also has -- you know, basically, it can be hooked up to devices that are not
15 sophisticated enough to be hooked up to a CAN device. This will allow the
16 benefits of the CAN network as far as control goes, and also compatibility
17 with far more devices than you would be able to connect directly to the CAN
18 network.

19 JUDGE WHITEHEAD: I'm sorry, you kind of faded off a little bit at
20 the end. Can you repeat that?

21 MR. OBERDICK: Oh, I'm sorry. So basically, the benefit of
22 providing the two networks is that you can achieve the benefits of the CAN
23 network as far as devices that are connectable to it, while at the same time
24 with the system overall, providing compatibility with a wider array of
25 devices because we're able to connect to devices that cannot transmit their
26 data for whatever reason over the CAN network. That's basically the main

1 purpose and gist of, of this Application. And I believe that all of the claims
2 share those common, those common elements.

3 Now, obviously the main cited reference is Bauer. Bauer is a very
4 early, very early example of centralized control in an operating room
5 environment. But Bauer really -- it discloses two completely separate
6 networks, and in our view, it doesn't disclose any single device that is in
7 communication with, with both networks which is also required by all of the
8 claims. Essentially, all of the claims require at least one device that is
9 receiving control signals, either directly or indirectly, and either through a
10 separate translator or through a translator that is a part of a different device
11 that is directly connected to the CAN network. So basically, a device that's
12 receiving control signals that are transmitted over the CAN network, while
13 at the same time outputting data via the second ancillary network, whether
14 it's because the data that is outputting is not compatible with the CAN
15 network or it has a higher bandwidth than the CAN network is capable of
16 transmitting. And it's Applicant's view that Bauer simply doesn't disclose
17 that, and the Examiner has admitted that Bauer doesn't disclose that which is
18 why the Examiner relies on the taking of Official Notice. And obviously a
19 great deal of time is spent in the papers objecting to the Examiner's taking of
20 Official Notice for several reasons. And without getting into the citations of
21 all of the MPEP sections, they were quite extensive that we cited in our
22 Appeal Brief that we believe -- support the position that this is not a proper
23 situation for the taking of Official Notice basically because (a) this whole
24 concept of a device that's connectible to two networks goes to the very heart
25 of the invention. If you look at the background of our Application, right
26 from the very beginning, you know, it's obvious that this system topography

1 is the very crux of the invention. All of the claims share these common
2 elements, so that this is not -- for that reason alone, the MPEP is pretty
3 specific. It says that you should not -- the Examiner should not take Official
4 Notice of matters that go to the heart of the invention, that basically taking
5 Official Notice should be reserved for peripheral matters that are basically
6 beyond dispute.

7 Also, the MPEP does say that if the Applicant challenges the taking of
8 Official Notice, the Examiner should provide some evidence, either a
9 reference or an affidavit, to essentially back up the taking of the Official
10 Notice. And that's essentially what the Applicant has been doing in this
11 case, basically just trying -- asking the Examiner to present a reference so
12 that at least the Applicant can challenge the reference, look at the teachings
13 of the reference, and try to point out maybe the Examiner just didn't really
14 understand the state of the art or the reference. In this case, the Applicant's
15 hands are essentially tied, for the most part, because the Examiner is taking
16 Official Notice. We really have no way of disputing or trying to point out if
17 there's a misunderstanding. Without a reference, it's very difficult to, you
18 know, to challenge the Examiner's Rejection.

19 Now finally, and for the very first time in the Examiner's Answer, he
20 does cite a reference as evidence of the taking of Official Notice which is
21 this Igarashi -- I'm sorry, it's I G A R -- I G A R A S H I, et al. And he cites
22 that reference for the proposition that it was very well known to connect a
23 single device, medical device, in this case it's a camera, to two networks.
24 But it's our contention, and when you -- you'll see we've specifically
25 addressed this in the Reply Brief, that actually that reference supports the
26 Applicant's position because it -- the device that it teaches is not connected

1 to two networks. It's only connected to one single network, which all along
2 has been what Applicant believes was the state of the art, and that's what
3 Bauer teaches and that's what's known. So again, even that reference, not
4 that it was cited as a reference, it was cited as evidence of the taking of
5 Official Notice, but, again, it doesn't support the taking of Official Notice,
6 and Applicant submits, actually contradicts the Examiner's position that it
7 was -- that this concept was extremely well known.

8 Do you have any questions?

9 JUDGE THOMAS: Any questions from the panel? Okay.

10 MR. OBERDICK: Okay, thank you. These guys usually want a
11 business card?

12 JUDGE THOMAS: That would be great, thank you.

13 Whereupon, the proceedings were concluded.

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